

Serial No.: 10/707,313
Atty Docket No.: 60655.2400

Remarks

In reply to the above-identified Office Action, Applicants amend the application and seek reconsideration thereof. In this reply, Applicants amend claims 1, 3, 5, 6, and 8, and add claims 10-12. Applicants do not cancel any claims. Applicants submit no new matter is added by these amendments. Accordingly, claims 1-12 are pending.

I. Claims Rejected under 35 U.S.C. § 112

The Examiner rejects claims 6-9 under 35 U.S.C. § 112, paragraph 2 asserting "In claims 6 and 8, 'nominated bank', 'credit', and 'required presentation' lack antecedent basis". In addition, claims 7 and 9 are rejected because of "their dependency upon rejected claims".

Applicants amend claims 6 and 8 to include appropriate antecedent basis for "nominated bank", "credit", and "required presentation". Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6-9.

II. Claims Rejected under 35 U.S.C. § 101

The Examiner rejects claims 1-5 under 35 U.S.C. § 101 asserting claims 1-5 are directed to non-statutory subject matter. Applicants respectfully traverse the rejection, but amend the application to expedite prosecution.

Applicants have amended claims 1-5 to recite a computer-implemented method in the preamble and structural elements in the claim body. Therefore, Applicants submit claims 1-5 are each directed to statutory subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-5.

III. Claims Rejected under 35 U.S.C. § 103

The Examiner rejects claims 1-9 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application No. 2004/0088245 filed by Narayan ("Narayan") in view of U.S. Patent Application No. 2002/0103754 filed by Dunlop ("Dunlop"). Applicants respectfully traverse these rejections.

To render a claim obvious, the cited references must teach or suggest every element of the claim. In making the rejection, the Examiner characterizes Narayan as reading on some elements of claim 1, but not teaching the elements of:

the nominated bank and said issuing bank have agreed to program conditions pursuant to which said nominated bank, based upon its

Serial No.: 10/707,313
Atty Docket No.: 60655.2400

own examination of said document and before said document is forwarded to, received, and accepted by the issuing bank, will at least one of pay, accept, and negotiate said credit with no or limited recourse to said issuing bank for discrepancies in said document; and said nominated bank examining said document for conformity to stipulated documents specified in said credit; and where said document is determined to be in conformity with said stipulated documents, and where provided in said program conditions, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for discrepancies in said document. See Paper No. 11162004, page 5.

In addition to claim 1, the Examiner does not characterize Narayan as showing any of the elements of claims 2-5. The Examiner relies on Dunlop to attempt to cure the defects of Narayan by asserting Dunlop teaches or suggests these elements, however, Applicants submit Dunlop fails to teach or suggest these elements of claims 1-5.

Dunlop teaches an InterNetLC[®] Letter of Credit, which is "an Internet alternative for Documentary Letter of Credit transactions." Dunlop, page 1, ¶ [0009] (emphasis added). Page 3, ¶ [0104] of Dunlop, in its entirety, states:

The InterNetLC (ILC) is the buyer's alternative to a documentary Letter of Credit. The TLC is support with either cash or a bank credit line, and is issued by a bank. It conforms to the International Chamber of Commerce Uniform Customs and Practices for Documentary Credits, Publication 500. The seller/beneficiary of said credit receives the ILC online via the Internet, and presents documents online via the Internet. The hardcopy originals are sent to the buyer at shipment the same as open account, while E-documents with the same information are sent to the issuing bank in html format. The ILC issuing bank will also participate as the advising bank, negotiation bank, and reimbursing bank. (emphasis added)

As such, Dunlop teaches a system that does not use Documentary Letters of Credit since it teaches using an instrument that is "an alternative to a documentary Letter of Credit." Thus, Dunlop does not teach or suggest the elements of the claims that Narayan fails to teach or suggest since these elements, among other things, define a method involving the use of a Documentary Letter of Credit. Moreover, Dunlop teaches that "The ILC bank will also participate as the advising bank, negotiation bank, and reimbursing bank," and therefore cannot teach or suggest "said nominated bank at least one of paying, accepting, and negotiating said

Serial No.: 10/707,313
Atty Docket No.: 60655.2400

credit with limited recourse to said issuing bank for discrepancies in said document" as recited in claim 1 since these limitations suggest that the nominated bank and the issuing bank are different banks, while Dunlop teaches that the ILC bank is both the nominated and issuing bank. Therefore, Dunlop fails to cure the defects of Narayan.

In addition, MPEP § 2143.01, under the heading, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS" states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in original). Applicants submit that it is inappropriate to combine Narayan and Dunlop since Narayan teaches systems and methods utilizing documents that are "consistent with a documentary credit instrument" (See Narayan, page 1, ¶ [0008]), whereas Dunlop teaches a system utilizing an instrument which is "an alternative to a documentary Letter of Credit" (See Dunlop, page 3, ¶ [0104]). As such, a system such as Dunlop which teaches an instrument (i.e., ILC) that is an alternative to a Documentary Letter of Credit cannot be combined with a system such as Narayan which teaches a Documentary Letter of Credit, under MPEP § 2143.01 to read on Applicants' claims.

Furthermore, MPEP § 2143.01, under the heading, "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" states, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Applicants submit that combining Narayan and Dunlop would render at least Dunlop unsatisfactory for its intended purpose. Particularly, the Examiner is using Dunlop, which teaches an instrument which has a main purpose of operating as an alternative to a Documentary Letter of Credit, to teach or suggest a portion of a system which uses a Documentary Letter of Credit, thereby clearly rendering the teachings of Dunlop unsatisfactory for its intended purpose.

Therefore, for the above reasons, Applicants submit the combination of Narayan and Dunlop fails to teach or suggest every element of claim 1. Thus, claim 1 is not obvious over Narayan in view of Dunlop. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1.

Serial No.: 10/707,313
Atty Docket No.: 60655.2400

Claims 2-5 each directly or indirectly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit claims 2-5 are not obvious over Narayan in view of Dunlop at least for the same reasons as claim 1, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-5.

Regarding independent claims 6 and 8, Applicants submit the obviousness discussion above with regard to independent claim 1 is equally applicable to similar elements recited in independent claims 6 and 8, namely, "said nominated bank, based upon its own examination of at least one document presented under a credit and before said document is forwarded to, received, and accepted by the issuing bank, will at least one of pay, accept, and negotiate said credit with limited recourse to said issuing bank for discrepancies in said document." Thus, the combination of Narayan and Dunlop fails to teach or suggest every element of claims 6 and 8. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6 and 8.

Claims 7 and 9 each directly or indirectly depend from claims 6 and 8, respectively, and contain all of the elements thereof. Therefore, Applicants respectfully submit claims 7 and 9 are not obvious over Narayan in view of Dunlop at least for the same reasons as claims 6 and 8, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 7 and 9.

IV. New Claims

Applicants present new claims 10-12 for examination. New claims 10-12 each include limitations similar to claims 1-9 discussed above. As such, Applicants are in condition for allowance at least for the same reasons as claims 1-9, in addition to their own respective features.

Serial No.: 10/707,313
Atty Docket No.: 60655.2400

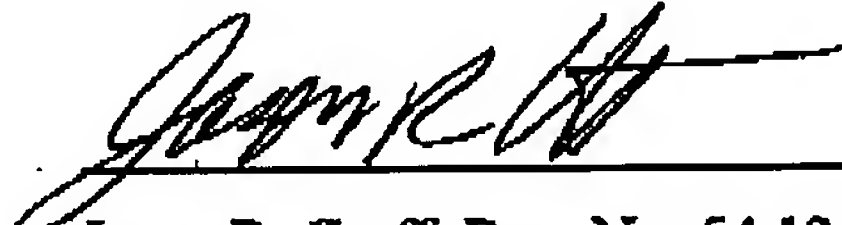
CONCLUSION

In view of the foregoing, it is believed that all claims now pending are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 1928-14 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

Dated: 1/27/05


Jason R. Graff, Reg. No. 54,134

SNELL & WILMER L.L.P.
400 E. Van Buren
One Arizona Center
Phoenix, Arizona 85004-2202
Phone: 602-382-6389
Fax: 602-382-6070
Email: jgraff@swlaw.com